

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

A. Claim amendments

Claim 81 is amended to incorporate the features of claim 1, and to be a method claims commensurate in scope with apparatus claim 1. It is respectfully submitted that no new matter is added, since the amendment merely merges the subject matter of previously presented claims.

Claims 1-80 are left unchanged.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

B. Rejection of claim 81 under 35 U.S.C. § 112 second paragraph

Reconsideration of this rejection is respectfully requested, in view of the amendments to claim 81, on the basis that amended claim 81 recites only a method of operating at least one banknote processing machine and a service center.

Accordingly, amended claim 81 is clear and definite and withdrawal of this rejection is respectfully requested.

C. Rejection of claim 81 under 35 U.S.C. § 101

Reconsideration of this rejection is respectfully requested, in view of the amendments to claim 81, on the basis that amended claim 81 recites only a method of operating at least one banknote processing machine and a service center and does not mix statutory classes.

Accordingly, amended claim 81 is considered to recite statutory subject matter and withdrawal of this rejection is respectfully requested.

2. Rejection of claims 1-10, 24-29, 31-38, 40-50, 58, 61-66, 68, 69, and 71-81 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 1. The remaining claims, except amended claim 81, depend from claim 1, and are therefore patentable as containing all of the recited elements of claim 1, as well as for their respective recited features. Amended claim 81 is, however, commensurate in scope with claim 1, and the discussion below is equally applicable to claim 1 as well as amended claim 81.

By way of review, the comments regarding the pending claims and the prior art documents presented in the response filed April 13, 2010 are incorporated herein by reference.

In particular, the embodiment of pending claim 1 requires a system comprising at least one banknote processing machine, which is connected to a service center by means of a network. The system is configured so that data necessary for operation of the at least one banknote processing machine and/or data produced during operation of the at least one banknote processing machine are exchanged between the banknote processing machine and the service center via the network. Log files or statistics about *increasing deviations or irregularities* occurring during operation of the at least one bank note processing machine are transmitted to the service center over the network, and the service center evaluates the log files or statistics and causes repairs to be carried out or wearing parts to be replaced before the at least one bank note processing machine fails.

Amended claim 81 similarly recites a method of for operating at least one banknote processing machine as well as a service center, comprising the steps of

providing a system comprising at least one banknote processing machine, which is connected to a service centre by means of a network; exchanging data necessary for operation of the at least one banknote processing machine and/or data produced during operation of the at least one banknote processing machine between the at least one banknote processing machine and the service centre via the network including transmitting log files or statistics about increasing deviations or irregularities occurring during operation of the at least one bank note processing machine; wherein the service center evaluates the log files or statistics and causes repairs to be carried out or wearing parts to be replaced before the at least one bank note processing machine fails.

In this manner, an active response approach to repair machines or replace wearing parts on an ongoing, continuous basis as the specific need arises (as detected by *increasing deviations or irregularities*) is provided.

In contrast to pending claim 1 and amended claim 81, the *Makino* publication discloses an ATM network where customer specific display screens and services are provided to individual customers based on stored attribute information for those customers (abstract; at least paragraphs [0009], [0010], [0016], [0061], and [0064]).

As acknowledged on page 4 of the Office action, the *Makino* publication fails to disclose log files or statistics about *increasing deviations or irregularities* occurring during operation of the ATMs being transmitted to a service center over a network, and the service center evaluating the log files or statistics and causing repairs to be carried out or wearing parts to be replaced before the ATMs fail, all as required by pending claim 1 and amended claim 81.

The Office action next turns to the *Irie* patent, which discloses a vibration monitor and monitoring method (title) which can correctly distinguish normal from abnormal vibration using automatically selected monitoring features and algorithms (abstract; col. 1, lines 5-12).

In particular, the vibration produced by the vibration system which is being monitored is detected by a sensor and a data processing device is employed to analyze the output of the sensor and to determine whether the vibration produced by the system being monitored is normal or abnormal (col. 2, lines 23-27).

When the system being monitored is vibrating normally, the data processing device is set in learning mode where the vibration waveform from the sensor is sampled over a given period, and this waveform is analyzed for numerous monitoring items which were determined beforehand such that the data associated with each monitoring items are subjected to statistical processing, and some predetermined number of the statistical data associated with the monitoring items are automatically selected which are recognized as a statistically stable data, which monitoring items are chosen to be monitored in operating mode, and an algorithm is generated to determine whether the vibration is normal or abnormal based on the data associated with the monitoring items which have been chosen (col. 2, lines 28-42).

When the learning mode operations have been concluded, the data processing device is operated in operating mode and the vibration waveform from the sensor is sampled as required and analyzed for the monitoring items determined in the learning mode and the data chosen for analysis are processed according to the algorithm which was generated in the learning mode, and a determination is made as to whether the vibration is normal or abnormal (col. 2, lines 43-52).

In other words, according to disclosure of the *Irie* patent, the waveform representing normal vibration which is input in learning mode is analyzed for a variety of sampling features where the monitoring features which will be actually used in operating mode are selected automatically out of the sampling features according to the results of the analysis (col. 2, lines 53-64).

In implementation, the upper and lower limits are established for the normal range for each monitoring feature and during the actual monitoring (i.e., in operating mode), the

judgment as to whether the vibration is abnormal is made by determining whether the value for the monitoring feature which is extracted is within the established range (col. 5, lines 18-23).

In other words, in contrast to claim 1 and amended claim 81 where log files or statistics about *increasing deviations or irregularities* occurring during operation of ATMs is transmitted to a service center over a network, and the service center evaluates the log files or statistics and causing repairs to be carried out or wearing parts to be replaced before the ATMs fail, the *Irie* patent merely discloses monitoring normal vibration, creating an algorithm to define the characteristics of normal vibration, and comparing data from a sensor to the normal vibration algorithm in order to identify abnormal vibration (step 202; col. 5, lines 46-51).

Thus, there is no disclosure or suggestion in the *Irie* patent of log files or statistics about *increasing deviations or irregularities* occurring during operation of ATMs being transmitted to a service center over a network, and the service center evaluating the log files or statistics and causing repairs to be carried out or wearing parts to be replaced before the ATMs fail, all as required by pending claim 1 and amended claim 81.

Even if the system of the *Irie* patent were added to the ATM network of the *Makino* patent, the proposed combination still fails to disclose or suggest at least log files or statistics about *increasing deviations or irregularities* occurring during operation of the ATMs, as is required by pending claim 1 and amended claim 81.

Accordingly, since the proposed combination of the *Makino* publication and the *Irie* patent fails to disclose or suggest every feature of pending claim 1 or amended claim 81, a *prima facie* case of obviousness cannot be established with respect to claim 1 and amended claim 81, and withdrawal of this rejection is respectfully requested.

As mentioned above, applicants submit that independent claim 1 is patentable and therefore, claims 2-10, 24-29, 31-38, 40-50, 58, 61-66, 68, 69, and 71-80, which depend

from claim 1, are also considered to be patentable as containing all of the elements of claim 1, as well as for their respective recited features.

3. Rejection of claims 11-20 and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*) and further in view of U.S. publication no. 2002/0046061 (*Wright et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Wright* publication fails to provide for the deficiencies of the proposed combination of the *Makino* publication and *Irie* patent as discussed above in detail with respect to claim 1, from which claims 11-20 and 22 depend.

Accordingly, withdrawal of this rejection is respectfully requested.

4. Rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*) and further in view of U.S. patent no. 6,508,398 (*Estes*)

Reconsideration of this rejection is respectfully requested on the basis that the *Estes* patent fails to provide for the deficiencies of the proposed combination of the *Makino* publication and *Irie* patent, as discussed above in detail with respect to claim 1, from which claim 21 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

5. Rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*) and further in view of U.S. patent no. 7,092,907 (*Kanevsky et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Kanevsky* patent fails to provide for the deficiencies of the proposed combination of the

Makino publication and *Irie* patent, as discussed above in detail with respect to claim 1, from which claim 23 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

6. Rejection of claims 30, 53-57, and 67 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*) and further in view of U.S. patent no. 6,430,470 (*Nakajima et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Nakajima* patent fails to provide for the deficiencies of the proposed combination of the *Makino* publication and *Irie* patent, as discussed above in detail with respect to claim 1, from which claims 30, 53-57, and 67 depend.

Accordingly, withdrawal of this rejection is respectfully requested.

7. Rejection of claim 39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*) and further in view of U.S. publication no. 2004/0164141 (*Egami et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Egami* publication fails to provide for the deficiencies of the proposed combination of the *Makino* publication and *Irie* patent, as discussed above in detail with respect to claim 1, from which claim 39 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

8. Rejection of claims 51 and 52 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*) and further in view of U.S. patent no. 7,395,241 (*Cook et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Cook* patent fails to provide for the deficiencies of the proposed combination of the *Makino* publication and *Irie* patent, as discussed above in detail with respect to claim 1, from which claims 51 and 52 depend.

Accordingly, withdrawal of this rejection is respectfully requested.

9. Rejection of claims 59 and 60 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*) and further in view of U.S. patent no. 6,363,164 (*Jones et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Jones* patent fails to provide for the deficiencies of the proposed combination of the *Makino* publication and *Irie* patent, as discussed above in detail with respect to claim 1, from which claims 59 and 60 depend.

Accordingly, withdrawal of this rejection is respectfully requested.

10. Rejection of claim 70 under 35 U.S.C. § 103(a) as being unpatentable over U.S. publication no. 2002/0035541 (*Makino et al.*) in view of U.S. patent no. 5,847,658 (*Irie et al.*) and further in view of U.S. publication no. 2008/0243915 (*Shah et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Shah* publication fails to provide for the deficiencies of the proposed combination of the *Makino* publication and *Irie* patent, as discussed above in detail with respect to claim 1, from which claim 70 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

11. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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